

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Applicant: Will G. FETHEROLF Title: VERTICAL MOUNT PRINTING DEVICE Appl. No.: 10/086,908 Filing Date: 02/28/2002 Examiner: Leonard S. Liang Art Unit: 2853	<table border="1" style="width: 100%; border-collapse: collapse;"><tr><td style="text-align: center; padding: 2px;"><u>CERTIFICATE OF FACSIMILE TRANSMISSION</u></td></tr><tr><td style="padding: 2px;">I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below.</td></tr><tr><td style="text-align: center; padding: 5px;"><i>Todd A. Rathe</i></td></tr><tr><td style="text-align: center; padding: 2px;">(Printed Name)</td></tr><tr><td style="text-align: center; padding: 5px;"> </td></tr><tr><td style="text-align: center; padding: 2px;">(Signature)</td></tr><tr><td style="text-align: center; padding: 5px;"> </td></tr><tr><td style="text-align: center; padding: 2px;">(Date of Deposit)</td></tr></table>	<u>CERTIFICATE OF FACSIMILE TRANSMISSION</u>	I hereby certify that this paper is being facsimile transmitted to the United States Patent and Trademark Office, Alexandria, Virginia on the date below.	<i>Todd A. Rathe</i>	(Printed Name)		(Signature)		(Date of Deposit)
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REPLY BRIEF ON APPEAL

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is in response to the Examiner's Answer mailed on February 5, 2007. For the following reasons, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims be issued.

I. Neither Silverbrook '430 nor Miyamoto, alone or in combination, disclose or suggest support supporting an external media input media processing engine along a vertical surface as set forth in claim 29, 58 and 59.

In the Appeal Brief, Appellant pointed out that neither Silverbrook '430 nor Miyamoto, alone or in combination, discloses or suggests a support supporting an external media input media processing engine along a vertical surface. In particular, Appellant pointed out that it would not be obvious to one of ordinary skill in the art to mount the printer phone of Silverbrook '430 in the holder of Miyamoto since such a

combination would destroy the intended functioning of a either Silverbrook '430 or Miyamoto.

In response to such points, the Examiner argues that such points are "flawed" by arguing that Miyamoto could be "adjusted" to receive the printer phone of Silverbrook '430. However, it is the Examiner's response that is flawed.

A. Regardless of where belts 3 of Miyamoto are positioned about the printer phone of Silverbrook '430, the functioning of either Silverbrook '430 or Miyamoto will be impaired.

The first "flaw" alleged by the Examiner is that Appellant overlooks the fact that the telephone holder of Miyamoto is "adjustable". (Examiner's Answer, pg. 13). However, Appellant has not overlooked the fact that belts 3 of Miyamoto are adjustable. Rather, Appellant has correctly recognized that adjusting belts 3 of Miyamoto to accommodate the printing of Silverbrook '430 will interfere with the intended use of the phone communication objectives of Miyamoto. Alternatively, adjusting the belts 3 of Miyamoto to accommodate the communication objectives of Miyamoto will interfere with the printing objectives of Silverbrook '430.

Miyamoto discloses as its main objective the ability to use a mobile phone in conjunction with a computer without having to hold onto the mobile phone. (Miyamoto, Paragraph [0004]). Obviously, to communicate with a mobile phone, one must be able to speak into a microphone and listen through a speaker of the phone. One must also be able to view the display screen of the phone. Recognizing this practicality, Miyamoto illustrates belts 3 as being positioned so as to not interfere with the microphone, the speaker or the display screen of the phone being supported. Instead, belts 3 are illustrated as extending across and partially between the key pads of the phone.

In contrast to the phone of Miyamoto, the printer phone of Silverbrook '430 cannot be supported by belts 3 of Miyamoto being positioned so as to extend across the keypad portion of the phone. As evident from Figure 1 of Miyamoto, doing so will result in belts 3 interfering with the printing objective of Silverbrook '430.

However, at the same time, there are no other locations at which belts 3 may alternatively be positioned so as to not interfere with microphone 3, speaker 2 or display screen 7. Positioning a belt below pushbuttons 6 of Silverbrook '430 will result in the belt either interfering with the edges of the paper being printed upon or at least partially covering microphone 3. Positioning one of belts 3 above pushbuttons 6 will result in the belt either interfering with the edges of the paper being printed upon, display screen 7 or speaker 2. One of ordinary skill in the art would not position belt 3 across the antenna. Thus, although it may be true that there is enough room to put belts 3 above and below the media input of the printer phone of Silverbrook '430, such "adjustment" of belts 3 would impair the phone communication objectives of Miyamoto.

- B. The alleged "adjustability" of Miyamoto is not a license for complete reconstruction of Miyamoto.

The Examiner repeatedly argues and at least implies that because Miyamoto describes its holder as being "adjustable" that the Examiner may practically rebuild or reconstruct the holder. As noted below, the Examiner takes the same position in order to reject claim 31. The Examiner's reconstruction of the holder of Miyamoto is improper.

In apparent acknowledgment that belts 3, regardless of their "adjusted" positions, will interfere with the communication objectives of Miyamoto or the printing objectives of Silverbrook '430 if the printer phone of Silverbrook '430 is mounted to the holder of Miyamoto, the Examiner attempts to completely reconstruct the holder of Miyamoto. In particular, the Examiner argues:

Given the adjustability of the support apparatus of Miyamoto, it is also apparent that the telephone in Silverbrook '430 could be rotated 90° and belts could be placed across the length of the telephone body to support the phone. . . . The Appellant will argue that the support legs 19 will necessarily block the media input in such a configuration. However, such an argument again overlooks the adaptability of the telephone holder

disclosed in Miyamoto. The legs could be placed far enough apart to not block the media input.

(Examiner's Answer, pg. 14) (Emphasis added). In a nutshell, the Examiner asserts that it would somehow be obvious (1) to mount the printer phone of Silverbrook '430 to the holder of Miyamoto in a horizontal orientation rather than a vertical orientation, (2) to completely reconstruct the wire frame of the holder of Miyamoto to extend the legs 19 far enough apart to not to block the media input AND (3) to increase the length of belts 3 to extend across the horizontal length of the printer phone of Silverbrook '430.

However, the Examiner's attempted reconstruction of Miyamoto is flawed for two reasons. First, Appellant respectfully notes that the fact that references **can** be combined or modified is not sufficient to establish prima facie obviousness. (In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); see also MPEP 2143.01 FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS). Although the Examiner attempts to argue (1) that the printer phone of Silverbrook '430 "**could**" be reoriented 90°, (2) that the holder of Miyamoto "**could**" be reconstructed to move legs 19 and (3) that the belts "**could**" be lengthened so as to extend across a horizontal length of the printer phone, this is not sufficient to establish a prima facie case of obviousness. As will be set forth in more detail with respect to claim 31, the Examiner fails to cite a single source, suggestion or motivation in either Silverbrook '430 or Miyamoto for such a complete reconstruction of the holder of Miyamoto. Nowhere does Silverbrook '430 or Miyamoto ever suggest a holder that supports any kind of a phone in a horizontal orientation rather than the vertical orientation illustrated in both Silverbrook '430 and Miyamoto.

Second, the Examiner's attempt to completely reconstruct the holder of Miyamoto overlooks the fact that such reconstruction would contradict the objectives of Miyamoto. Using the holder of Miyamoto to support the printer phone of Silverbrook '430 in a horizontal orientation would result in the belts 3 extending across an even larger area of the face of the printer phone of Miyamoto. Belts 3

would extend across and interfere with use of each of the microphone, the speaker, the keypad and the display of the phone being supported. Moreover, extending a belt horizontally across a horizontal length of the printer phone of Silverbrook '430 would clearly be much less stable and in direct contradiction to the objective of Miyamoto to provide a holder that offers a secure and stable support for a phone. (See Miyamoto, Paragraph [0012]). Accordingly, the rejection of independent claims 29, 58 and 59 and their dependent claims should be reversed.

II. Neither Silverbrook '430 nor Miyamoto, alone or in combination, disclose or suggest a support supporting an external media input media processing engine along a vertical surface such that the media processing engine has a top-to-bottom media path as set forth in claim 31.

Claim 31 depends from Claim 29 and additionally recites that the device, when vertically oriented, has a height, a width and a depth, wherein the first face and the second face each define the width and the depth of the engine and wherein the depth is smaller than the height and the width. In other words, because the media input and the media output are provided in the first face and the second face, respectively (as recited in claim 29), movement of media through the engine is along a generally vertical or top-to-bottom path.

In the Appeal Brief, Appellant pointed out that neither Silverbrook '430 nor Miyamoto disclose or even suggest a support supporting an external media input media processing engine along a vertical surface and having such a top-to-bottom media path. Appellant also pointed out that the Examiner has failed to cite any valid motivation for modifying the holder of Miyamoto so as to support the printer phone of Silverbrook '430 in a horizontal orientation such that it would have a top-to-bottom media path.

In response to such points, the Examiner once again relied upon the assertion that the holder of Miyamoto is "adjustable." However, the Examiners rejection of claim 31 is improper because (1) "adjustability" is not a license to completely reconstruct the holder of Miyamoto in any fashion just to support a claim rejection

and (2) the fact that the holder of Miyamoto could be modified is NOT sufficient to establish prima facie obviousness.

- A. Adjustability is not a license for the Examiner to completely reconstruct the holder of Miyamoto in order to reject claim 31.

The Examiner repeatedly argues and at least implies that because Miyamoto describes its holder as being "adjustable" that the Examiner may practically rebuild or reconstruct the holder. Once again, the Examiner argues:

Given the adjustability of the support apparatus of Miyamoto, it is also apparent that the telephone in Silverbrook '430 could be rotated 90° and belts could be placed across the length of the telephone body to support the phone. *In such an orientation, the media would still be in a vertical orientation, but the media would be fed in an up and down direction.* The Appellant will argue that the support legs 19 will necessarily block the media input in such a configuration. However, such an argument again overlooks the adaptability of the telephone holder disclosed in Miyamoto. The legs could be placed far enough apart to not block the media input.

(Examiner's Answer, pg. 14) (Emphasis added). In order to reject claim 31, the Examiner attempts to perform multiple unsupported "adjustments," namely: (1) mounting the printer phone of Silverbrook '430 to the holder of Miyamoto in a horizontal orientation rather than a vertical orientation, (2) completely reconstructing the wire frame of the holder of Miyamoto to widen the legs 19 far enough apart to not block the media input AND (3) increasing the length of belts 3 to extend across the horizontal length of the printer phone of Silverbrook '430.

Despite the fact that such "adjustments" require a complete reconstruction of the holder of Miyamoto, the Examiner cannot point to a single legitimate motivation or suggestion in either Silverbrook '430 or Miyamoto for such "adjustments". Rather, the Examiner takes the following positions:

NOTE: For purposes of this rejection figure 1 of Silverbrook, et al. will be viewed in an orientation 90° to the orientation shown in the figure. The reoriented figure 1 is shown below.

(Examiner's Answer, p. 3.);

The figures of Miyamoto are simply representative figures, which the Examiner do not believe are meant to be binding.

(Examiner's Answer, pg. 16).

Clearly, the Examiner does not wish to be bound by anything that Silverbrook '430 or Miyamoto actually disclose. Not only has the Examiner failed to point to any teaching or suggestion supporting the Examiner's reconstruction of the holder of Miyamoto, but the Examiner appears to be taking the position that he has the freedom to modify or "adjust" the holder of Miyamoto in any fashion as he desires to reject claim 31 so long as Miyamoto does not expressly prohibit such "adjustments." This is not the law. The law requires the Examiner to point to some suggestion or motivation to establish a prima facie case of obviousness.

B. The fact that the holder of Miyamoto could be modified is NOT sufficient to establish prima facie obviousness.

The Examiner rejects claim 31 because the holder of Miyamoto "could" be adjusted in the multiple fashions (set forth above) required to read upon the limitations of claim 31. In rejecting claim 31, the Examiner presents arguments that are focused on how Miyamoto allegedly does not prohibit these required adjustments. The Examiner argues:

Miyamoto does not disclose its support system to be limited to a specific phone orientation.

(Examiner's Answer, pg. 16).

The Examiner also attempts to argue that since the alleged main purpose of Miyamoto is to provide a hands-free support and since the "adjustments" proposed by the Examiner would not impair this alleged primary purpose of Miyamoto, such adjustments "could" be made. In particular, the Examiner argues:

The phone does not have to be oriented in a specific direction to accomplish this primary motivation of creating a hands-free system. ... Furthermore, the Appellant is

reminded that a cellular phone is a portable device, which can be held by a support in a number of ways, without interfering with its main function. The main teaching of Miyamoto is that it provides an adaptable system for portable telephones such that a user's hands can be freed (paragraph 0005). The orientation by which a phone is placed in the adaptable support does not change the fact that it is indeed placed in the support, and thus accomplishes the primary purpose of freeing hands.

(Examiners Answer, pg. 16).

However, this argument is completely irrelevant. In fact, this argument appears to flip the burden of proof requirements regarding the establishment of a prima facie case of obviousness upside down. The law does not require Appellant to prove that the combined references teach away from the alleged combination. (In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); see also MPEP 2143.01 FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS). In contrast, the well-settled law is that, to establish a prima facie case of obviousness, the Examiner has the burden of identifying some suggestion or motivation in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the references in order to reject a claim. (See MPEP 2142-2143). As noted above, the Examiner has failed to meet his burden. Accordingly, the rejection of claim 31 should be reversed.

III. Neither Silverbrook '430 or Miyamoto, alone or in combination, disclose or suggest a method wherein an external media input media processing engine is supported along a vertical surface and wherein discharged printed upon media is held below the media output as set forth in claim 61.

As noted above with respect to the rejection of claim 31, the Examiner has failed to establish a prima facie case of obviousness for "adjusting" the holder of Miyamoto to alternatively support the printer phone of Silverbrook '430 in a horizontal orientation such that the printer phone has a top-to-bottom media path. As a result, the Office Action has also failed to establish a prima facie case of obviousness for modifying the support of Miyamoto such that discharged printed upon sheets are

held below the media output. For this reason and the same reasons set forth in the Appeal Brief, the rejection of claim 61 should be reversed.

IV. Neither Silverbrook '430, Miyamoto nor Silverbrook '349, alone or in combination, disclose or suggest an external media input processing engine supported along a vertical surface having a media input configured to receive media having a width of at least 8 inches as set forth in Claims 45-46.

In the Appeal Brief, Appellant pointed out the Examiner fails to cite any motivation or suggestion for modifying entry slot 31 of the printer phone 1 of Silverbrook '430 to have a width of at least 8 inches. One of ordinary skill in the art would not be led to reconfigure printer phone 1 of Silverbrook '430 such that its entry slot 31 has a dimension of at least 8 inches since the title itself of Silverbrook '430 recites that the phone is to "hand held" and "mobile". Enlarging printer phone 1 of Silverbrook '430 such that entry slot 31 has a dimension of at least 8 inches would destroy the intended function of printer phone as being a handheld mobile phone. Practicality would dictate one of ordinary skill in the art against such a hypothetical modification of Silverbrook '430.

In responding to such points, the Examiner argues that:

8 inches can still be considered portable. Take for example a portable laptop computer using Voice over IP technology. The dimensions of a laptop are usually over 8 inches, but it is still considered a portable system, which also provides a telephonic service.

(Examiner's Answer, pg. 17).

Despite the Examiner's arguments, the meaning of the term "portable" obviously must be defined in the context of the article being described. For example, "portable" basketball backboards are eight to 10 feet in length. A phone or even a laptop eight to 10 feet in length would not be considered "portable". In the present case, one of ordinary skill in the art would not consider a phone that is well over 8 inches long to be "portable." Accordingly, it would not be obvious to modify the printer phone of Silverbrook '430 to have a media input at least 8 inches long.

Again, the mere fact that the printer phone of Silverbrook '430 "could" be modified while still preserving its alleged fundamental principle of portable printing does not meet the requirements for establishing a prima facie case of obviousness. Thus, the rejection of claims 45 and 46 should be reversed.

V. Neither Silverbrook '430, Miyamoto nor Silverbrook '349, alone or in combination, disclose or suggest an external input media processing engine supported along a vertical surface and a receiver that receives media from the media output and supports the media in a tilted orientation directed away from the vertical surface as set forth in claim 51.

In the Appeal Brief, Appellant pointed out that it would not be obvious to modify the alleged combination of Silverbrook '430 Miyamoto two additionally include the tray of Silverbrook '349 since both the tray in the holder of Silverbrook '430 and Miyamoto, respectively, would have to be substantially reconstructed. Moreover, the Examiner fails to cite any motivation for such a complete reconstruction.

In response, the Examiner argues that "Appellant is narrowing the scope of the claimed invention by over-focusing on where Tray 619 of Silverbrook '349 is located." However, it is the disclosed location of the tray of Silverbrook '349 that would lead one of ordinary skill in the art not to add it to the printer phone of Silverbrook '430. In fact, nowhere to Silverbrook '430 or Silverbrook '349 even mention any desirability for the addition of a tray, let alone a tray that supports media in a tilted orientation directed away from a vertical surface. Appellant notes once again that it is the Examiner's burden to establish a prima facie case of obviousness by identifying a motivation or suggestion in the cited references which would lead to the alleged modification. The Examiner has failed to do this. Accordingly, rejection of claim 51 should be reversed.

VI. Neither Silverbrook '430, Miyamoto nor Silverbrook '349 disclose or suggest any input configured to receive an individual sheet from a stack of media proximate the input or the step of positioning a stack of sheets of media proximate the media input as set forth in claims 55 and 60.

In the Appeal Brief, Appellant pointed out that the Examiner has failed to cite a single source of motivation for the allegedly obvious modification of adding the media tray 607 of Silverbrook '349 to the printer phone of Silverbrook '430. Appellant noted that to somehow add an internal print tray 607 and disclosed by Silverbrook '349 would destroy the intended purpose of Silverbrook '430 of providing a handheld mobile phone and would require a complete reconstruction of the mobile printer phone of Silverbrook '430.

In response to such points, the Examiner asserts that:

The Examiner believes that the most telling evidence against the Appellant's argument is that both Silverbrook '349 and Silverbrook '430 are directed to cell phone printers.

(Examiner's Answer, pg.19).

Appellant wishes to point out that the Examiner's statement is **flat wrong** and completely untrue. Nowhere does Silverbrook '349 disclose that it is describing a cell phone printer. The fact that Silverbrook '430 discloses a cell phone printer while Silverbrook '349 has nothing to do with phones is the most telling evidence that it would not be obvious to modify Silverbrook '430 based upon Silverbrook '349. Thus, the rejection of claims 55 and 60 should be reversed. . Accordingly, Appellant respectfully requests that the Board reverse all claim rejections and indicate that a Notice of Allowance respecting all pending claims should be issued.

Summary

For the foregoing, it is submitted that the Examiner's rejections are erroneous, and reversal of the rejections is respectfully requested.

Dated this 4th day of April, 2007.

Respectfully submitted,

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